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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,577	01/24/2002	Naohiro Hirose	KON-1707	5337
20311	7590	09/01/2004	EXAMINER	
MUSERLIAN AND LUCAS AND MERCANTI, LLP 475 PARK AVENUE SOUTH NEW YORK, NY 10016			RODEE, CHRISTOPHER D	
			ART UNIT	PAPER NUMBER
			1756	

DATE MAILED: 09/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/056,577	Applicant(s) HIROSE ET AL.	
	Examiner Christopher RoDee	Art Unit 1756	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 2-5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 6-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

Claims 2-5 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected processes, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 28 August 2003. The basis for the restrictions presented in the Office action of 29 January 2003 remains applicable to the amended claims.

### *Allowable Subject Matter*

The indicated allowability of claims 1 and 6-8 is withdrawn in view of the newly discovered reference(s) to Nozawa *et al.* in US Patent 6,555,281 and Hashimoto *et al.* in US Patent 6,610,454. Rejections based on the newly cited reference(s) follow. Prosecution on the merits is reopened in order to make these new grounds of rejection.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 6-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Nozawa *et al.* in US Patent 6,555,281.

Nozawa discloses in Example 34 a toner having a binder resin and a colorant with SF-1 of 160 and SF-2 of 136. The ratio of SF-1/SF-2 is 1.18. This example has 8.0 number % of particles with a size of 4 microns or less and an average size of 7.1 microns (Table 11 relying on Table 7, col. 33, l. 47-55). Based on the small number of particles having a size of 4 microns or less and the average particle size at 7.1 microns it appears that the reference inherently has less than 5 % by number of particles with a size of 0.60 to 1.00 microns according to the method of determination required by the claims. Further, the reference specifically discloses as small as 3 % number of particles having a size of 4 microns or smaller (col. 11, l. 9-30). This value would by necessity produce less than 5 % by number of particles with a size of 0.60 to 1.00 microns according to the method of determination required by the claims.

Claims 1 and 6-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Hashimoto *et al.* in US Patent 6,610,454.

Hashimoto discloses a toner having a binder resin and a colorant, which, in Example 11 has SF-1 of 135 and SF-2 of 111 to give a ratio of SF-1/SF-2 of 1.22. The average particle size of this toner is 6.4 microns. Based on the average particle size at 6.4 microns it appears that the reference inherently has less than 5 % by number of particles with a size of 0.60 to 1.00 microns according to the method of determination required by the claims because few particles would be present at sizes substantially far from the average. This example is particularly pertinent to claims 1 and 6.

Hashimoto also discloses in Example 29 a toner having the requisite components and SF-1 of 158 and SF-2 of 140 to give a ratio of SF-1/SF-2 of 1.13. The average particle size of this toner is 10.5 microns. Based on the average particle size at 10.5 microns it appears that the reference inherently has less than 5 % by number of particles with a size of 0.60 to 1.00

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microns according to the method of determination required by the claims because few particles would be present at sizes substantially far from the average. This example is particularly pertinent to claims 1, 7, and 8.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. .

Claim 8 now specifies that the value SF-2 is 130 to 165. Although the specification does provide basis for this limitation for SF-1 (see spec. p. 12), the specification does not basis for this limitation for SF-2, particularly because SF-1 and SF-2 must be different to give the requisite ratio of SF-1/SF-2 in base claim 1.

Applicants are advised that status identifiers must be used correctly. Claim 8 is stated as being previously presented but an amendment is present for this claim.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher RoDee whose telephone number is 571-272-1388. The examiner can normally be reached on most weekdays from 6:00 to 4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cdr  
31 August 2004



**CHRISTOPHER RODEE**  
**PRIMARY EXAMINER**